

REMARKS

Applicants respectfully request that the following remarks be made of record.

Before reviewing in detail applicants' specific claim limitations that are not taught, described, or suggested by Freedman, a few general comments may assist Examiner understand the overall differences between applicants' invention and the Freedman device.

The most significant difference between applicants' invention and the Freedman device is that applicants' invention produces production-ready output (plates, films, etc.) used to produce a printed, engraved, embossed, or lithographed product; the Freedman device merely produces "pricing and administrative information concerning the printing of the work" (Freedman, page 1, Abstract). Freedman's described device develops price quotes, estimates printing times and materials usage, and provides other administrative information to determine the most appropriate way to print a work based on the print requester's criteria (Freedman, column 10, lines 16-26). However, the Freedman device does not typeset a work—that is, it does not output a work that is in a final format ready for printing. Freedman's device is far from an "automated typesetting system" as described in applicants' specification and identified in applicants' preamble. *See* MPEP §2111.02 *citing In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) (if the prior art structure is incapable of performing the intended use as recited in the preamble, then it does not meet the claim). Applicants' preamble limitation to an "automated typesetting system," as described in applicants' specification, should be accorded patentable weight. *See generally* MPEP §2111.02.

Freedman's device is not an "automated typesetting system." To the extent typesetting information (typeface, point size, leading, kerning, etc.) is used by Freedman, it is merely to provide sufficient information to the printing facility to "quickly and accurately provide a cost estimate for a particular job, as well as estimates of required materials, manpower, production scheduling, machine controls, waste management, management reporting and management communication or messaging" (Freedman, column 10, lines 58-63). Freedman's device leaves off by sending "all job [specifications] and cost [figures] ... to the appropriate printing facility" for

printing of the work (Freedman, Fig. 2B; column 10, lines 26-32). Under Freedman's invention, the printing facility merely receives the raw data for the job (the text, graphics, desired formatting, etc.), but a "printing manager" still needs to manually enter the job data and format and typeset the product to be produced (Freedman, columns 10-12). At best, even when using Freedman's device, formatting and typesetting the work for production, along with actual production of the work, are far from automatic. None of the prior art shortcomings identified in applicants' specification are solved by the Freedman device.

Applicants' invention picks up where Freedman left off. Applicants' invention produces production-ready output. Applicants' invention eliminates the need for a printing manager and permits a printing facility to automatically format and typeset a job for production. Applicants' invention is a true automated typesetting system, not a printing control system. Applicants' invention, as taught in above identified amended claims, is patentable over Freedman.

In the spirit of the preceding comments, applicants respectfully traverse Examiner's rejection of Claims 1 through 5 and 7 through 9 under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829). Applicants have reviewed the Freedman '829 patent and amended some of their claims. Applicants respectfully request Examiner reconsider his objections in light of the amended claims and the following comments.

Claim 1

To anticipate a claim, **the cited reference must teach every element of the claim.** MPEP §2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Id. citing Verdegall Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown as in complete detail as is contained in the ... claim." *Id. citing Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants' amended independent Claim 1 includes several specific, positive limitations that are not taught or suggested by Freedman. Therefore, applicants' amended Claim 1 should be allowed.

Applicants' amended Claim 1 describes an automated typesetting system used to produce a commercially-printed product according to a customer's corporate identity specifications, comprising, first, a means for creating, designing, storing, accessing, and updating an electronic graphic template of the product according to said customer's corporate identity specifications. Examiner cites Freedman Fig. 1A, and column 8, lines 21-45 and 56-68, as anticipating this element of applicants' claim. However, a careful review of the cited data shows one key element of applicants' claim is missing in the Freedman device—there is no means to update Freedman's templates. Freedman does not teach, explicitly or implicitly, a means to update standard or custom templates. A user of the Freedman device may either use an existing template or create a new template; updating or revising templates is not contemplated. Therefore, this portion of applicant's Claim 1 is not anticipated by Freedman.

Applicants' automated typesetting system as described in amended Claim 1 further comprises means for creating, designing, programming, storing, accessing, and updating an electronic database file, wherein said database file is programmed to receive and store populating data used to populate said electronic graphic template and said database file is further programmed with instructions and parameters used to format said populating data on said electronic graphic template according to said customer's corporate identity specifications. Examiner cited Freedman (column 7, lines 37-52) as anticipating this element of applicants' claim. However, Freedman again does not teach several limitations of applicants' Claim 1, namely, there are no means to design or program Freedman's database file and there is no means to program Freedman's database file with instructions and parameters used to format populating data on the template. Therefore, this portion of applicants' Claim 1 is not anticipated by Freedman.

Applicants' automated typesetting system as taught in amended Claim 1 also comprises a means for automatically populating said populating data into said electronic graphic template. Examiner argues that Freedman (column 8, lines 45-48) anticipates this element of applicants' Claim 1. However, Freedman does not describe such a means. A user of Freedman's device can "batch load the entire manuscript into the computer in the desired form." A batch upload of data is

not the equivalent of automatically populating data into a template. Moreover, Freedman's batch data upload is not automatic; a user must coordinate and operate the batch upload. Therefore, this portion of applicants' Claim 1 is not anticipated by Freedman.

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Finally, applicants' automated typesetting system, as described in applicants' original Claim 1, comprises a means for automatically formatting said populating data on said template according to the customer's corporate identity specifications to form a populated and formatted template. Examiner cited Freedman (column 8, lines 40-44) as anticipating this element of applicants' device. Applicants respectfully disagree that the cited Freedman disclosure ("[t]he computer provides the requester with a number of possible formats which could be selected. The formats made available for selection are typical of those employed in the printing industry or to a particular customer or type of work.") describes a means for automatically formatting said populating data on said template according to the customer's corporate identity specifications to form a populated and formatted template. Freedman's use of the words "formats" refers to general template formats (book, newsletter, etc.), not typesetting formats based on corporate identity specifications. Freedman does not disclose a means for automatically populating and formatting text and images on a template. Therefore, this portion of applicants' amended Claim 1 is not anticipated by Freedman.

Col. 8
L. 56-68

Claim 2

Applicants respectfully traverse Examiner's rejection of Claim 2 under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829) and request Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros.*, 2 USPQ2d at 1053. "The identical invention must be shown as in complete detail as is contained in the ... claim." *Richardson*, 9 USPQ2d at 1920. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." 37 C.F.R. 1.75(c).

Dependent Claim 2 teaches the automated typesetting system as recited in Claim 1. As discussed above, Freedman clearly does not anticipate applicants' Claim 1, as Freedman does not teach each and every element and limitation of Claim 1. Therefore, Freedman does not teach each and every element of dependent Claim 2 and Claim 2 cannot be anticipated by Freedman.

Nevertheless, applicants' have amended Claim 2 to further distinguish their invention from the Freedman device (applicants also have amended Claim 2 to clarify any ambiguity between their "electronic graphic template" and their "populated and formatted template"). Applicants' amended Claim 2 include the specific limitation that production-ready output is automatically produced using said populated and formatted template to produce said commercially-printed product. Freedman's device, as described above, is not used to produce a formatted template in a production-ready format; Freedman's device only produces information to help a user select how to best proceed with a printing job based on various variables and criteria. A user of the Freedman device still must revert to prior art methods to actually get a work produced. Applicants' invention picks up where Freedman leaves off and provides a means to produce production-ready output. Therefore, applicants' amended Claim 2 is not anticipated by Freedman.

Claim 3

Applicants have amended Claim 3 to clarify any ambiguity between their "electronic graphic template" and their "populated and formatted template."

Applicants respectfully traverse Examiner's rejection of Claim 3 under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829) and request Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros.*, 2 USPQ2d at 1053. "The identical invention must be shown as in complete detail as is contained in the ... claim." *Richardson*, 9 USPQ2d at 1920. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." 37 C.F.R. 1.75(c).

Dependent Claim 3 teaches the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not anticipate applicants' Claims 1 or 2, as Freedman does not teach each and every element and limitation of Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claim 3 and Claim 3 cannot be anticipated by Freedman.

Claim 4

Applicants have amended Claim 4 to clarify any ambiguity between their "electronic graphic template" and their "populated and formatted template."

Applicants respectfully traverse Examiner's rejection of Claim 4 under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829) and request Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros.*, 2 USPQ2d at 1053. "The identical invention must be shown as in complete detail as is contained in the ... claim." *Richardson*, 9 USPQ2d at 1920. "Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." 37 C.F.R. 1.75(c).

Dependent Claim 4 teaches the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not anticipate applicants' Claims 1 or 2, as Freedman does not teach each and every element and limitation of Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claim 4 and Claim 4 cannot be anticipated by Freedman.

Claim 5

Applicants have amended Claim 5 to clarify any ambiguity between their "electronic graphic template" and their "populated and formatted template."

Applicants respectfully traverse Examiner's rejection of Claim 5 under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829) and request Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. "A claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros.*, 2 USPQ2d at 1053. “The identical invention must be shown as in complete detail as is contained in the ... claim.” *Richardson*, 9 USPQ2d at 1920. “Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.” 37 C.F.R. 1.75(c).

Dependent Claim 5 teaches the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not anticipate applicants’ Claims 1 or 2, as Freedman does not teach each and every element and limitation of Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claim 5 and Claim 5 cannot be anticipated by Freedman.

Claim 7

Applicants have amended Claim 7 to clarify any ambiguity between their “electronic graphic template” and their “populated and formatted template.”

Applicants respectfully traverse Examiner’s rejection of Claim 7 under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829) and request Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros.*, 2 USPQ2d at 1053. “The identical invention must be shown as in complete detail as is contained in the ... claim.” *Richardson*, 9 USPQ2d at 1920. “Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.” 37 C.F.R. 1.75(c).

Dependent Claim 7 teaches the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not anticipate applicants’ Claims 1 or 2, as Freedman does not teach each and every element and limitation of Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claim 7 and Claim 7 cannot be anticipated by Freedman.

Claim 8

Applicants have amended Claim 8 to clarify any ambiguity between their “electronic graphic template” and their “populated and formatted template.”

Applicants respectfully traverse Examiner’s rejection of Claim 8 under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829) and request Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros.*, 2 USPQ2d at 1053. “The identical invention must be shown as in complete detail as is contained in the ... claim.” *Richardson*, 9 USPQ2d at 1920. “Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.” 37 C.F.R. 1.75(c).

Dependent Claim 8 teaches the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not anticipate applicants’ Claims 1 or 2, as Freedman does not teach each and every element and limitation of Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claim 8 and Claim 8 cannot be anticipated by Freedman. Moreover, Examiner’s argument relies on Freedman (column 11, lines 36-38). Applicants have carefully reviewed the cited language and found no language describing or teaching a means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template. Freedman’s simply does not contain such an element. Significantly, Freedman’s device relies heavily on a “printing manager” who must make a number of decisions regarding the actual printing of a work (i.e., paper stock, dimensions, plate types, finishes, bindery, etc.). Applicants’ invention is automatic; there is no need for a “printing manager” to make such choices. Clearly, applicants’ Claim 8 is not anticipated by Freedman.

Claim 9

Applicants respectfully traverse Examiner’s rejection of Claim 9 under 35 U.S.C. 102(b) as being anticipated by Freedman (U.S. Patent 4,839,829) and request Examiner reconsider. To anticipate a claim, the reference must teach every element of the claim. MPEP §2131. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or

inherently described, in a single prior art reference.” *Verdegaal Bros.*, 2 USPQ2d at 1053. “The identical invention must be shown as in complete detail as is contained in the ... claim.” *Richardson*, 9 USPQ2d at 1920. “Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.” 37 C.F.R. 1.75(c).

Dependent Claim 9 teaches the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not anticipate applicants’ Claims 1 or 2, as Freedman does not teach each and every element and limitation of Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claim 9 and Claim 9 cannot be anticipated by Freedman.

Claim 6

Applicants respectfully traverse Examiner’s rejection of Claim 6 under U.S.C. 103(a) as obvious based on Freedman (U.S. Patent 4,839,829) in view of Cupps et al. (U.S. Patent 5,991,739). To establish a *prima facie* case of obviousness under 35 U.S.C. 103, three basic criteria must be met: there must be some suggestion or motivation to modify the reference or combine the references, there must be a reasonable expectation of success, and **the prior art reference must teach or suggest all the claim limitations**. MPEP §706.02(j). “Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.” 37 C.F.R. 1.75(c).

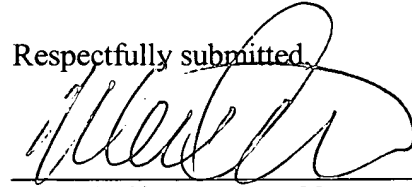
Dependent Claim 6 teaches the automated typesetting system as recited in Claims 1 or 2. As discussed above, Freedman clearly does not teach or suggest all the claim limitations in applicants’ Claims 1 or 2. Therefore, Freedman does not teach each and every element of dependent Claim 6 and Claim 6 cannot be anticipated by Freedman. Since Freedman does not teach or suggest all of the claim limitations of Claim 6, a *prima facie* case of obviousness under 35 U.S.C 103 cannot be made. Therefore, applicant’s dependent Claim 6 would not have been obvious to one of ordinary skill in the art of automated typesetting systems, and Claim 6 is patentable over Freedman in light of Cupps et al.

CONCLUSION

With this Amendment, applicants believe that their application is in condition for allowance and an early issuance of the Notice of Allowability is respectfully requested.

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Respectfully submitted,



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VERSION OF CLAIMS WITH MARKINGS TO SHOW CHANGES MADE

1 (Amended). An automated typesetting system used [for production] to produce commercially-printed product according to a customer's corporate identity specifications, comprising:

means for creating, designing, storing, accessing, and updating an electronic graphic template of [the] said product according to [the] said customer's corporate identity specifications;

means for creating, designing, programming, storing, accessing, and updating an electronic database file, wherein said database file is programmed to receive and store populating data used to populate said electronic graphic template and said database file is further programmed with instructions and parameters used to format said populating data on said electronic graphic template according to [the] said customer's corporate identity specifications;

means for inputting said populating data into said database file as database records;

means for automatically populating said populating data into said electronic graphic template; and

means for automatically formatting said populating data on said electronic graphic template according to [the] said customer's corporate identity specifications to form a populated and formatted template.

2 (Amended). The automated typesetting system of claim 1 further comprising a means for automatically [printing] producing production-ready output using said populated and formatted template to produce said commercially-printed product.

3 (Amended). The automated typesetting system of claims 1 or 2, in which said electronic graphic template is comprised of at least one block designed to contain populating data in the form of text or graphics.

4 (Amended). The automated typesetting system of claims 1 or 2, in which said database file is comprised of at least one field designed to contain populating data and at least one field

designed to contain instructions and parameters used to format said populating data on said electronic graphic template according to [the] said customer's corporate identity specifications.

5 (Amended). The automated typesetting system of claims 1 or 2, in which said means for creating, designing, storing, accessing, and updating [an] said electronic graphic template comprises a computer software program and said means for creating, designing, programming, storing, accessing, and updating [an] said electronic database file comprises a computer software program.

6. The automated typesetting system of claims 1 or 2, in which said means for inputting said populating data into said database file as database records comprises:

- a Web site programmed to receive said populating data; and
- a populating data import means for automatically importing said populating data into said database file as database records.

7 (Amended). The automated typesetting system of claims 1 or 2 further comprising a means for electronically proofchecking and correcting said populating data prior to automatically populating said populating data into said electronic graphic template.

8 (Amended). The automated typesetting system of claims 1 or 2, in which said means for automatically populating said populating data into said electronic graphic template further comprises a means for fully populating said electronic graphic template should said populating data not fully populate said electronic graphic template.

9. The automated typesetting system of claims 1 or 2 interactively coupled with an automated order tracking, billing, shipping, and inventory control system.